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Entertainment Company Ltd.

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

**C06 07317 RMW**

LUCASFILM LTD. and LUCASFILM  
ENTERTAINMENT COMPANY LTD.,

Plaintiffs,

v.

WILLIAM L. OSBURN dba HIGH-TECH  
MAGIC, and DOES 1-10,

Defendants.

CASE NO.:

**HRL**

COMPLAINT FOR INFRINGEMENT  
OF TRADEMARKS AND TRADE  
DRESS, DILUTION OF  
TRADEMARKS AND TRADE  
DRESS, UNFAIR COMPETITION,  
AND FALSE ADVERTISING

DEMAND FOR JURY TRIAL

CERTIFICATION OF INTERESTED  
PARTIES

Plaintiffs Lucasfilm Ltd. and Lucasfilm Entertainment Company Ltd. (collectively, "Lucasfilm" or "Plaintiffs") hereby allege for their Complaint against Defendants William L. Osburn dba High-Tech Magic and Does 1-10 (collectively, "High-Tech Magic" or "Defendants") on personal knowledge as to their own actions and on information and belief as to the actions of others as follows:

**THE PARTIES**

1. Plaintiff Lucasfilm Ltd. is a privately held corporation organized and existing under the laws of the State of California, with its principal place of business in Marin County, California.

COMPLAINT



1 corporations with their principal places of business in California, and such acts caused harm that  
2 Defendants knew or should have known was likely to be suffered in California.

3 8. Venue is proper in this Court under 28 U.S.C. § 1391(b) because a substantial part  
4 of the events or omissions giving rise to the claims occurred in this district, Plaintiffs' principal  
5 places of business are in this district, and Plaintiffs have suffered harm in this district.

#### 6 **INTRADISTRICT ASSIGNMENT**

7 9. Pursuant to Civil L.R. 3-2(c), this action may be assigned on a District-wide basis  
8 because it is an Intellectual Property Action.

#### 9 **BACKGROUND**

10 10. High-Tech Magic has engaged in the unauthorized use of Lucasfilm's trademarks  
11 and trade dress to promote, advertise and sell infringing goods.

#### 12 **Lucasfilm's Trademarks and Trade Dress**

13 11. Lucasfilm Ltd. is one of the most celebrated film and entertainment companies in  
14 the world, producing some of the most famous motion pictures ever created. Lucasfilm Ltd. and  
15 its related companies and facilities have won over 30 Academy Awards and 12 Emmy Awards,  
16 including many for innovation in the field of visual effects.

17 12. Lucasfilm Ltd. is the producer of the epic Star Wars film series, the creation of  
18 writer-producer-director George Lucas. Ever since the first Star Wars film premiered in 1977,  
19 the Star Wars saga has been a world-wide cultural phenomenon. Star Wars broke all box office  
20 records and spawned a series of five more feature films (collectively, the "Star Wars Motion  
21 Pictures"), each of which is among the highest grossing motion pictures in United States box  
22 office history.

23 13. As proclaimed in the introduction to the Star Wars Motion Pictures, the Star Wars  
24 saga takes place "a long time ago in a galaxy far, far away." Over the course of three decades,  
25 the Star Wars Motion Pictures have transported audiences to exotic planets where good and evil  
26 engage in an epic struggle to control the universe. The climactic scenes of the Star Wars Motion  
27 Pictures feature exciting and memorable duels between the heroes (Jedi Knights), and the villains  
28 (Sith Lords), using swords of pure energy, called Lightsabers.

1           14.     The immense popularity of the Star Wars Motion Pictures created a world-wide  
2 market for Star Wars licensed products including action figures, costumes, role-playing toys,  
3 books, comics, video games, trading cards, and numerous other products. Lucasfilm Ltd. and its  
4 affiliated company Lucasfilm Entertainment Company Ltd. oversee the manufacture, licensing,  
5 promotion, and sales of the consumer products business for Star Wars. Licensing of products  
6 related to the Star Wars Motion Pictures generates substantial revenue for Lucasfilm.

7           15.     Prominent among Lucasfilm's licensed products are replicas of the Star Wars  
8 Lightsaber swords featured in the Star Wars Motion Pictures ("Star Wars Lightsaber Swords").  
9 The Star Wars Lightsaber Swords feature a combination of elements including a cylindrical  
10 blade, which is slightly tapered at the tip, and which lights up with bright, glowing color from the  
11 base of a silver and black hilt to the top of the blade (the "Lightsaber Trade Dress"). Lucasfilm  
12 has used the Lightsaber Trade Dress continuously since the premiere of the first Star Wars film  
13 in 1977.

14           16.     Star Wars Lightsaber Swords are central symbols in the Star Wars Motion  
15 Pictures. To date, tens of millions of licensed Star Wars Lightsaber Swords have been purchased  
16 by the general public. In 2005 alone, Lucasfilm's licensees sold over 10,000,000 replica Star  
17 Wars Lightsaber Swords. Lucasfilm and its licensees also display Star Wars Lightsaber Swords  
18 prominently on and in connection with the sale of other licensed Star Wars products.

19           17.     Lucasfilm owns numerous U.S. trademark registrations covering role-playing toys  
20 and toy weapons, including STAR WARS (Reg. No. 2487818); LIGHTSABER (Reg. Nos.  
21 1126220 and 2772052); JEDI (Reg. No. 2595365); THE FORCE (Reg. No. 2884498), and  
22 DARTH MAUL (Reg. No. 2540704) (collectively, the "Lucasfilm Trademarks").

23           18.     The Lucasfilm Trademarks (except for DARTH MAUL, which first appeared in a  
24 later film released in 1999) have been in continuous use in interstate and international commerce  
25 by Lucasfilm and its licensees in connection with the sale of toys related to the STAR WARS  
26 Motion Pictures since at least as early as the premiere of the first Star Wars film in 1977.

27           19.     As a result of the phenomenal success of the Star Wars Motion Pictures and three  
28 decades of extensive marketing and promotion in and on Star Wars related advertising,

1 packaging and products, the Lucasfilm Trademarks and the Lightsaber Trade Dress are famous,  
2 have acquired secondary meaning in connection with the sale of Star Wars related products, and  
3 are strongly associated with Lucasfilm and the Star Wars Motion Pictures in the minds of the  
4 general public.

5 **Defendants' Infringing Conduct**

6 20. Defendants have willfully used the Lucasfilm Trademarks in connection with the  
7 unauthorized advertisement and sale of Defendants' own versions of Lucasfilm's Star Wars  
8 Lightsaber Swords on their website at [www.High-TechMagic.com](http://www.High-TechMagic.com).

9 21. When entering the High-Tech Magic website, consumers are greeted with a  
10 statement that "We do Star Wars™ LIGHT SABRES." [sic] The statement appears next to a  
11 picture showing a man holding a product embodying a look and feel which is identical or  
12 confusingly similar to the Lightsaber Trade Dress (the "Infringing Product"). The web page also  
13 allows visitors to click on a link that connects the consumer to various "Star Wars" products  
14 featured on the site.

15 22. Once the consumer clicks on the link to the "Star Wars" products, a new web  
16 page opens, titled "Star Wars™ Light Sabers." Next to the same picture of a man holding an  
17 Infringing Product, the website states: "Do you like Star Wars™? Would you like to own a Star  
18 Wars™ Lightsaber that looks as good as those in the movies? High-Tech Magic sells electronic  
19 Lightsabres at a reasonable price." [sic] This web page repeatedly displays the trademarks  
20 STAR WARS, JEDI, and THE FORCE, in addition to the mark LIGHTSABER, in connection  
21 with the sale of unauthorized Infringing Products.

22 23. From this web page, a button labeled "Star Wars" leads the consumer to the full  
23 Infringing Products online catalogue page. The catalogue page is titled "Star Wars Products,"  
24 and the trademarks STAR WARS, LIGHTSABER, and THE FORCE are featured prominently  
25 and repeated numerous times within the body of the web page in connection with the sale of  
26 Infringing Products and their component parts. The web page also features the character name  
27 (and Lucasfilm trademark) DARTH MAUL in connection with an Infringing Product which is  
28

1 identical or confusingly similar to the red, double-headed Star Wars Lightsaber Sword that is  
2 associated with that particular character.

3 24. High-Tech Magic is also using Lucasfilm's STAR WARS and LIGHTSABER  
4 trademarks as metatags in the HTML code for its website. The website's metatags, which can  
5 affect the prominence of the website in some Internet search engine results, read: <META  
6 content="Star Wars Lightsabers,Light Sabres,Plasma Sabers,Electroluminescent lightsabers,EL  
7 lightsabers,high-tech" name=KEYWORDS>.

8 **Irreparable Harm to Lucasfilm**

9 25. Defendants' use of the Lucasfilm Trademarks and the Lightsaber Trade Dress is  
10 likely to cause confusion or mistake or deception of purchasers as to the source of origin of  
11 Defendants' goods.

12 26. Because of the confusion as to source engendered by Defendants' use of the  
13 Lucasfilm Trademarks and the Star Wars Lightsaber Trade Dress, purchasers are likely to  
14 purchase goods sold on Defendants' website believing they are Lucasfilm's products, associated  
15 or affiliated with Lucasfilm, or sponsored or endorsed by Lucasfilm, thereby resulting in a loss  
16 of sales for Lucasfilm.

17 27. Because of the confusion as to source engendered by Defendants' use of the  
18 Lucasfilm Trademarks and the Lightsaber Trade Dress, Lucasfilm's valuable goodwill is at the  
19 mercy of Defendants, and the quality, or lack thereof, of Defendants' related goods. Defendants'  
20 conduct threatens irreparable injury to Lucasfilm's goodwill, business, and reputation.

21 28. Defendants' actions in violation of Lucasfilm's trademark and trade dress rights  
22 have been willful, malicious, and in complete disregard of Lucasfilm's interests.

23 29. Lucasfilm has been damaged by, and Defendants have profited from, Defendants'  
24 wrongful conduct in an amount to be proven at trial.

25 30. Defendants' wrongful conduct has caused and is continuing to cause irreparable  
26 injury to Lucasfilm and to the business, reputation, and goodwill represented thereby, and unless  
27 enjoined will cause further irreparable injury, from which Lucasfilm has no adequate remedy at  
28 law.

**FIRST CAUSE OF ACTION**

Infringement of Registered Trademarks

(15 U.S.C. § 1114)

31. Lucasfilm hereby incorporates and realleges the allegations of paragraphs 1 through 30 above.

32. Lucasfilm is the owner of federal trademark registrations for STAR WARS, LIGHTSABER, JEDI, THE FORCE, and DARTH MAUL.

33. Defendants have used in commerce, without Lucasfilm's consent, trademarks that are identical to Lucasfilm's federally registered marks in connection with identical or confusingly similar goods.

34. Defendants' use of the Lucasfilm Trademarks is likely to cause confusion, mistake, or deception among consumers.

35. As a consequence of Defendants' infringement of the Lucasfilm Trademarks, Lucasfilm is entitled to an injunction as set forth below, an order of destruction of all Defendants' infringing materials, Defendants' profits, Lucasfilm's damages, and Lucasfilm's costs of action. Moreover, because this is an exceptional case, involving willful misconduct by Defendants, Lucasfilm is entitled to recover treble damages, treble profits, and attorneys' fees.

**SECOND CAUSE OF ACTION**

Violation of Lanham Act § 43(a)

(15 U.S.C. § 1125(a))

36. Lucasfilm incorporates and realleges the allegations of paragraphs 1 through 35 above.

37. Defendants' conduct, including its use in commerce of trademarks and trade dress that is identical or confusingly similar to the Lucasfilm Trademarks and the Lightsaber Trade Dress, is likely to cause confusion, mistake, or deception as to the source, sponsorship, affiliation, or approval of Defendants' goods. Further, Defendants' acts described above constitute false representations of fact that are also likely to cause confusion, mistake, or deception as to the source, sponsorship, affiliation, or approval of Defendants' goods.







1           44. Defendants' conduct constitutes willful trademark and trade dress infringement  
2 under the common law of the State of California.

3           45. Defendants' actions described above have greatly and irreparably damaged  
4 Lucasfilm and will continue to damage Lucasfilm unless enjoined by this Court. Lucasfilm is  
5 entitled to an injunction as well as damages to be proved at trial. Moreover, because of  
6 Defendants' willful and malicious conduct, Lucasfilm is entitled to exemplary damages in an  
7 amount to be determined by a jury.

8                                   **FIFTH CAUSE OF ACTION**

9                                   Common Law Unfair Competition

10          46. Lucasfilm repeats and realleges the allegations of paragraphs 1 through 45 above.

11          47. Defendants' acts as described above constitute unfair competition in violation of  
12 the common law of the State of California.

13          48. Defendants' acts described above have greatly and irreparably damaged  
14 Lucasfilm and will continue to damage Lucasfilm unless enjoined by this Court. Lucasfilm is  
15 entitled to an injunction as set forth below, as well as damages to be proved at trial.

16                                   **SIXTH CAUSE OF ACTION**

17                                   Unfair Competition

18                                   (Cal. Bus. & Prof. Code § 17200 et seq.)

19          49. Lucasfilm repeats and realleges the allegations of paragraphs 1 through 48 above.

20          50. Defendants' use of trademarks and trade dress that is identical or confusingly  
21 similar to those used by Lucasfilm constitutes unfair deceptive, untrue, and misleading  
22 advertising.

23          51. Defendants' acts described above are unlawful, unfair, or fraudulent business acts  
24 or practices, constituting unfair competition in violation of California Bus. & Prof. Code § 17200  
25 et seq.

26          52. Defendants' acts described above have greatly and irreparably damaged  
27 Lucasfilm and will continue to damage Lucasfilm unless enjoined by this Court. Accordingly,  
28

1 Lucasfilm is entitled to an injunction under Cal. Bus. & Prof. Code § 17203, as well as  
2 restitution and disgorgement of Defendants' profits.

3 **SEVENTH CAUSE OF ACTION**

4 False and Deceptive Advertising

5 (Cal. Bus. & Prof. Code § 17500 et seq.)

6 53. Lucasfilm repeats and realleges the allegations of paragraphs 1 through 52 above.

7 54. Defendants' ongoing offers to sell its goods in connection with the Lucasfilm  
8 Trademarks and the Lightsaber Trade Dress are disseminated to and received by the public in  
9 California. Defendants have engaged in these actions with the intent to sell its goods, and/or to  
10 induce the public to purchase Defendants' goods. Such actions (which are likely to deceive the  
11 public as to the source, sponsorship, affiliation, or approval of Defendants' goods) constitute  
12 unfair, deceptive, untrue, or misleading advertising under Cal. Bus. & Prof. Code § 17500 et seq.

13 55. Defendants' acts described above have greatly and irreparably damaged  
14 Lucasfilm and will continue to damage Lucasfilm unless enjoined by this Court. Accordingly,  
15 Lucasfilm is entitled to an injunction under Cal. Bus. & Prof. Code § 17535, as well as  
16 restitution and disgorgement of Defendants' profits.

17 **PRAYER FOR RELIEF**

18 WHEREFORE, Plaintiffs request entry of judgment in their favor and against Defendants  
19 as follows:

20 a. That the Court preliminarily and permanently enjoin Defendants, their  
21 subsidiaries, parent, and affiliated companies, successors, assigns, officers, directors, agents,  
22 partners, servants, and employees of those companies or individuals, and all others in active  
23 concert or participation with Defendants, from using any of Lucasfilm's trademarks or trade  
24 dress, in particular the trademarks STAR WARS, LIGHTSABER, JEDI, THE FORCE, or  
25 DARTH MAUL, or the Lightsaber Trade Dress, or any trademark or trade dress that is likely to  
26 cause confusion with, or cause dilution of, any of Lucasfilm's trademarks or trade dress, in  
27 particular the trademarks STAR WARS, LIGHTSABER, JEDI, THE FORCE, or DARTH  
28 MAUL, or the Lightsaber Trade Dress;

- 1           b.       That the Court require Defendants to destroy all infringing merchandise;
- 2           c.       That the Court order Defendants, and all others enjoined in this action, to file with
- 3 the Court and serve on Lucasfilm within 30 days of the Order an affidavit setting forth in detail
- 4 the manner in which they have complied with the terms of the Order;
- 5           d.       That the Court require Defendants to account for and pay to Lucasfilm treble the
- 6 amount of all profits derived by Defendants as a result of the acts alleged in this action;
- 7           e.       That the Court require Defendants to pay to Lucasfilm treble the amount of all
- 8 damages incurred by Lucasfilm by reason of Defendants' acts alleged in this action;
- 9           f.       That the Court order Defendants to make restitution to Lucasfilm for the amounts
- 10 derived by virtue of Defendants' unfair business practices.
- 11           g.       That the Court award Lucasfilm the costs of this action, together with reasonable
- 12 attorneys' fees and disbursements;
- 13           h.       That the Court grant such other and further relief as the Court deems just and
- 14 proper.

15

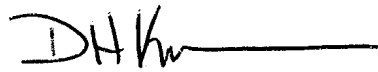
16 Dated: November 28, 2006

WILSON SONSINI GOODRICH & ROSATI

17

18

19 By:



20 DAVID H. KRAMER

21 Attorneys for Plaintiffs Lucasfilm Ltd. and

22 Lucasfilm Entertainment Company Ltd.

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**DEMAND FOR JURY TRIAL**

Plaintiffs hereby demand a trial by jury on all issues so triable in this action.

Dated: November 28, 2006

WILSON SONSINI GOODRICH & ROSATI

By:



DAVID H. KRAMER

Attorneys for Plaintiffs Lucasfilm Ltd. and  
Lucasfilm Entertainment Company Ltd.

**CERTIFICATION OF INTERESTED ENTITIES OR PERSONS**

Pursuant to Civil L.R. 3-16, the undersigned certifies that as of this date, other than the named parties, there is no such interest to report.

Dated: November 28, 2006

WILSON SONSINI GOODRICH & ROSATI

By:

  
DAVID H. KRAMER

Attorneys for Plaintiffs Lucasfilm Ltd. and  
Lucasfilm Entertainment Company Ltd.